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10/811,527	03/29/2004	Fred Naval Desai	8768MD2	1921

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THE PROCTER & GAMBLE COMPANY  
Global Legal Department - IP  
Sycamore Building - 4th Floor  
299 East Sixth Street  
CINCINNATI, OH 45202

EXAMINER
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HAND, MELANIE JO

ART UNIT	PAPER NUMBER
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3761

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/811,527	<b>Applicant(s)</b> DESAI ET AL.	
	<b>Examiner</b> MELANIE J. HAND	<b>Art Unit</b> 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 37-54 is/are pending in the application.
- 4a) Of the above claim(s) 46 and 54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-45 and 47-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/13/09</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. It is noted that this action is final because, though it is in response to an election of species requirement, applicant's amendment to the claims in the previous reply cancelling all pending claims and presenting new claims would have caused any subsequent action on the merits to be final. Further, this action is also final because the new grounds of rejection presented herein were prompted by applicant's submission of an information disclosure statement after a non-final action was mailed.

### ***Election/Restrictions***

2. Applicant's election with traverse of the species having an elastic component that is a leg elastomeric member, a geometric pattern that is continuous, a substrate that is nonwoven fibrous web and the differing property between elastomeric members being differing mechanical properties in the reply, claims 37-45 and 47-53, filed on February 12, 2009 is acknowledged. The traversal is on the ground(s) that there would be no undue burden on the examiner to search and examine claims directed to all species. This is not found persuasive because the requirement was based upon the fact that the species are physically mutually exclusive with respect to one another, e.g. a substrate cannot simultaneously be woven and nonwoven or a geometric pattern cannot simultaneously be continuous and intermittent.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 46 and 54 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. With respect to claim 46, as stated below in the Specification section of this action, the specification does not provide sufficient antecedent basis for members that differ in elastic properties and thus elastic properties are interpreted as being distinct from mechanical properties. In light of

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this elastomeric members that differ in elastic properties are not a feature of the elected embodiment. Claim 54 recites an article with an elastomeric waist member, which is not a feature of the elected embodiment.

### ***Response to Arguments***

4. Applicant's arguments filed February 12, 2009 have been fully considered but they are not persuasive. The arguments in their entirety are directed to the election of species requirement and are thus not persuasive for reasons stated *supra* in the "Elections/Restrictions" section of this Office action.

### ***Information Disclosure Statement***

5. The information disclosure statement (IDS) submitted on February 13, 2009 was filed after the mailing date of the non-final action on July 10, 2008. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Specification***

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: there is no antecedent basis for members that differ in elastic properties. The specification therefore sets forth a distinction between elastic properties and mechanical properties and the claims are interpreted in light of this distinction.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 37, 38, 40-43 and 47-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Morman (U.S. Patent No. 5,910,224).

With respect to **claim 37**: Morman discloses an absorbent article, the absorbent article comprising an elastic component, the elastic component comprising a first substrate in the form of a neckable material 12 having an elastomeric composition in the form of elastic layer 27 of elastomeric precursor material 26 applied directly via a printing method in a predetermined geometric pattern of rectilinear stripes. (Fig. 7, Col. 6, lines 53-57) The pattern defined by elastic layer 27 comprises at least two individual elastomeric members in a repeating pattern differing in a property, namely differing mechanical properties between the elastomeric members based upon their placement/position on the necked substrate 12, such that the elastomeric composition 26 of layer 27 partially penetrates the first substrate, wherein the elastomeric composition necessarily comprises a phase change solvent. Examiner's position regarding the differing mechanical properties is based upon Morman's disclosure that the precursor is applied in a pattern of members spaced apart from one another. These members will differ in their recovery from expansion inasmuch as they are printed into the necked substrate and thus their mechanical behavior is dictated largely, if not entirely, by the substrate. As the substrate is a necked material, those members in the transverse central part of the article will stretch and

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recover differently than, for example, members in the waist region near the side edges.

Examiner's position regarding a phase change solvent is based upon applicant's disclosure that the phase change solvent is a material that lowers melt viscosity and renders the composition it is part of processable at temperatures at or below 175 degrees C without compromising elastic or mechanical properties, and Morman's disclosure that the elastomeric composition, precursor 26, is applied to the neckable material and the laminate placed in an oven at 103 degrees C to form the elastic layer exhibiting excellent elastic and recovery properties, i.e. the composition is processable at 103 degrees C, which is below 175 deg. C. (Col. 16, lines 32-36)

With respect to **claim 38**: Morman discloses that the elastic component, i.e. the substrate 12 with elastic layer 27 thereon, forms a reversibly necked material taught by reference to U.S. Patent No. 4,965,122 to Morman. (224, Col. 5, lines 49-58) In the '122 patent, Morman discloses in Example 3 and Table 6 an elastic component having a permanent set or percent set, of 11-15%, which overlaps the claimed range of a percent set less than about 20%.

With respect to **claim 40**: Morman discloses that the predetermined geometric pattern is an intermittment pattern. (Col. 5, lines 4-7)

With respect to **claim 41**: The elastomeric members disclosed by Morman have a width dimension of 0.95 cm, or 9.5 mm, which falls within the claimed range of at least about 2.0 mm. (Col. 16, lines 51-54) Examiner's position is based upon Example 3 of Morman wherein Morman discloses that the elastomeric composition is applied around 0.5 inch pieces of tape spaced apart by 0.95 cm in the transverse direction of the substrate. Thus the width of the members will

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be defined by and equal to the spacing between tape pieces prior to removal and heating to “set” the composition in the substrate.

With respect to **claim 42**: The elastomeric members as disclosed by Morman and applied in the precursor composition form have a thickness dimension of 0.1-100 mils, or 0.003-2.5 mm, which overlaps the claimed range of at least about 0.1 mm. (Col. 6, lines 42-46)

With respect to **claim 43**: The elastomeric members disclosed by Morman are in a repeating intermittent pattern, i.e. spaced apart from one another. (Col. 5, lines 4-7)

With respect to **claim 47**: The substrate disclosed by Morman is an SMS laminate, i.e. a nonwoven fibrous web. (Col. 8, lines 4-12)

With respect to **claim 48**: The fibers disclosed by Morman comprise a polyolefin material, namely polypropylene, taught by reference to the ‘122 patent. (‘122, Col. 10, lines 39, 40)

With respect to **claim 49**: The elastic component disclosed by Morman has been necked, i.e. incrementally stretched. (Col. 4, lines 23-35)

With respect to **claim 50**: The elastic component disclosed by Morman further comprises a second substrate, i.e. a second layer, joined to the first substrate to form a laminate, wherein the elastomeric composition is disposed between the first and second substrates. (Col. 10, lines 43-45)

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With respect to **claim 51**: Morman discloses that the second substrate is an elastic sheet wherein Morman discloses that the term "sheet" means a film. (Col. 10, lines 42-45, Col. 4, lines 60, 61)

With respect to **claim 52**: The printing method disclosed by Morman is gravure. (Col. 6, line 59)

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 39, 44 and 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morman ('224) in view of Vukos et al (WO 02/34182 A2).

With respect to **claim 39**: Morman discloses that the elastic component of the invention is used in diapers, but does not explicitly recite that the elastic component is used in a diaper as any of a topsheet, a backsheet, an outer cover, an ear, a side panel, a waist member, a leg elastomeric member, a chassis member, a fastener, a fastener with slot and tab or combinations thereof. Vukos discloses an absorbent article where in the outer cover 40 is made from the elastic component of the '224 patent used as the primary reference herein to provide optimal stretch in desired directions for a form fitting article. ('182, Page 13, lines 18-23)



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Therefore, it would be obvious to one of ordinary skill in the art to use the article of Morman as an outer cover (backsheet) in the article of Vukos to provide optimal directional stretch for a form fitting article.

With respect to **claim 44**: Morman does not explicitly disclose that the elastic component comprises at least one additional elastomeric composition disposed on the substrate. Vukos discloses an absorbent article where in the outer cover 40 is made from the elastic component of the '224 patent used as the primary reference herein to provide optimal stretch in desired directions for a form fitting article. ('182, Page 13, lines 18-23) Vukos discloses elastic members 80 and 82 that are applied to the outer cover 40 as a thermoplastic elastomeric polymer, i.e. at least one additional composition disposed on the substrate, outer cover 40. ('182, Page 17, lines 19-24) Vukos discloses that this imparts elastic constrictive forces to the substrate 40 ('182, Page 17, lines 23-25), which would further contribute to a more customized fit on the user. Thus, it would be obvious to one of ordinary skill in the art to modify the article of Morman such that at least one additional elastomeric composition disposed on the substrate as disclosed by Vukos to provide impart elastic constrictive forces to the substrate in the desired area for a more customized fit.

With respect to **claim 45**: Morman does not explicitly disclose that the elastic component comprises at least one additional elastomeric composition disposed on the substrate or that a second composition is applied in a pattern different from the first composition. The elastic component of Vukos comprises first and second elastomeric compositions, the first integral with the outer cover as disclosed by reference to the '224 patent to Morman and the second composition applied in a pattern to form waist and/or leg elastic members 80,82. ('182, Page 17,

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lines 19-24) The second composition is disposed on the substrate in a pattern different than the first composition inasmuch as the pattern of the first composition is a series of zones of elastomer spaced apart from each other and the second composition is applied as transversely extending waist members or longitudinally extending leg members in a limited and specific area. The motivation to use the article of Morman as an outer cover in the article of Vukos having a second composition applied thereon is stated *supra* with respect to claim 44.

11. Claim 53 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Morman ('224).

With respect to **claim 53**: The elastomeric member disclosed by Morman and formed from the precursor composition 26 inherently has a melt viscosity of from about 1 to about 150 Pa-s, measured at 175 °C and 1/s and an elasticity of at least about 50 N/m. Examiner's position is based upon Morman's disclosure of styrene-ethylene/butylene-styrene as the elastomeric precursor material, which is identical to a material disclosed by applicant for the recited elastomeric member. (Specification, Page 3, lines 27-32) If the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. When the structure or composition recited in the reference is substantially identical to that of the claimed invention, claimed properties or functions are presumed to be inherent. See MPEP §2112-2112.01. A prima facie case of either anticipation or obviousness has been established when the reference discloses all of the limitations of a claim except for a property or function and the examiner cannot determine whether or not the reference inherently possesses properties that anticipate or render obvious the claimed invention but has a basis for shifting the burden of proof to the applicant. See *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980).

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Alternatively, it would be obvious to one of ordinary skill in the art to modify the article of Morman such that the elastomeric composition has a melt viscosity within the claimed range with a reasonable expectation of success to ensure that the composition can be effectively processed and applied to the substrate as intended.

### ***Conclusion***

12. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on February 13, 2009 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELANIE J. HAND whose telephone number is (571)272-6464. The examiner can normally be reached on Mon-Thurs 8:00-5:30, alternate Fridays 8:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melanie J Hand/  
Examiner, Art Unit 3761